

REMARKS

By this Amendment, Applicants amend claims 1-3, 5-7, 17-25, and 29-32 and add new claims 33 and 34. Claims 1-34 are therefore pending in this application.

In the Office Action of December 20, 2004,¹ claims 9-16 and 25-32 were allowed and claims 1-8 and 17-24² were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,377,530 to *Burrows* (“*Burrows*”) in view of U.S. Patent No. 5,903,871 to *Terui et al.* (“*Terui*”). Applicants acknowledge with appreciation the Examiner’s indication of allowable subject matter and address the rejection and new claims below.

Prior to addressing the rejection, Applicants point out that claims 25 and 29-32 have been amended to improve form. Applicants submit that claims 25 and 29-32 remain in condition for allowance.

Section 103(a) rejection of claims 1-8 and 17-24

With regard to claims 1-8 and 17-24, Applicants traverse the § 103(a) rejection of those claims because a case for *prima facie* obviousness has not been established. To establish *prima facie* obviousness under § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

² Applicants point out that the Examiner did not include claim 24 in the statement of rejection (OA at 2, item 2). Because the substance of the rejection addressed claim 24, however, Applicants assume claim 24 was rejected under 35 U.S.C. § 103(a) with claims 1-8 and 17-23 and respond to the rejection accordingly.

requirements must “be found in the prior art, and not be based on applicant’s disclosure.”

M.P.E.P. § 2143 (8th ed. 2001).

Independent claim 1 recites a combination including:

means for determining whether or not said reproducing means performs a reproduction when a recording command is issued; and

means for disabling said reproducing means and enabling said recording means when said determining means determines that said reproducing means performs the reproduction when the recording command is issued.

Burrows, which is directed to playing compressing audio data (Abstract), does not teach or suggest at least the above-noted features. In fact, the Examiner acknowledged that *Burrows* fails to disclose means for detecting that reproducing means performs a reproduction when a recording command is issued or means for disabling the reproducing means and enabling the recording means when the detecting means detects that said reproducing means performs the reproduction (Office Action “OA” at 2).

Terui does not cure *Burrows*’s deficiencies. *Terui* is directed to voice recording and reproducing (Abstract). *Terui* merely discloses recording when a recording (REC) button is activated (FIG. 12, S39; col. 11, lines 11-15) and performing reproduction when a reproduction (PLAY) button is activated (FIG. 12, S41; col. 12, lines 21-24). *Terui* does not teach or suggest “means for determining whether or not said reproducing means performs a reproduction when a recording command is issued” and “means for disabling said reproducing means and enabling said recording means when said determining means determines that said reproducing means performs the reproduction when the recording command is issued,” as recited in claim 1.

The Examiner alleged that *Terui* discloses “a method of determining whether recording is on (Fig. 12 S38) or playing is on (Fig. 12 S40)” (OA at 2). *Terui* merely discloses various “operation buttons and switches” (Fig. 1; col. 4, lines 38-40) as well as determining whether “the

pressed button is the recording button” and whether “the playing button . . . has been pressed” (col. 11, lines 11-13; col. 12, lines 21-23; Fig. 12, S38, S40). Determining whether a REC or PLAY button has been pressed does not teach or suggest “means for determining whether or not said reproducing means performs a reproduction when a recording command is issued” and “means for disabling said reproducing means and enabling said recording means when said determining means determines that said reproducing means performs the reproduction when the recording command is issued,” as recited in claim 1.

Accordingly, the applied references, taken alone or in combination, do not teach or suggest each and every element recited in the claim 1. As such, *prima facie* obviousness has not been established with respect to claim 1 and the § 103(a) rejection of that claim should be withdrawn.

Furthermore, the requisite motivation to combine *Burrows* and *Terui* is lacking. Determinations of obviousness must be supported by evidence on the record. *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). Further, the desire to combine or modify references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *See In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

In this case, the Office Action does not show that a skilled artisan considering *Burrows* and *Terui*, and not having the benefit of Applicants’ disclosure, would have combined the references in a manner resulting in Applicants’ claimed combination. The Examiner alleged that a skilled artisan would have combined the references “in order to facilitate recording and file

transfers” (OA at 3). The Examiner averred that [i]t is desirable to avoid corrupted data and data loss and by monitoring when recording is to be done, this can be eliminated” (OA at 3). The statements by the Examiner are not properly supported by evidence and do not show that a skilled artisan would have combined the references as alleged.

Applicants call attention to M.P.E.P. § 2143.01, which makes clear that: “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (citations omitted). The Office Action does not show that the cited art “suggests the desirability” of the alleged combination. Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used in hindsight to reconstruct the prior art. For at least these additional reasons, *prima facie* obviousness has not been established with respect to claim 1 and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Independent claim 5 recites a combination including “means for selectively setting an operation mode” and “means for controlling said recording means and said reproducing means in accordance with the operation mode set by said setting means when said determining means determines that the apparatus is connected to the external device.” *Burrows* does not teach or suggest at least these features. In fact, the Examiner acknowledged that *Burrows* fails to disclose “setting an operation mode” and “means for controlling said recording means and said reproducing means in accordance with the operation mode . . .” (OA at 4).

Terui does not cure *Burrows*’s deficiencies. The Examiner alleged that *Terui* discloses “multiple playback control buttons (Fig. 1 element 19) . . . and a method of determining whether recording is on (Fig. 12 S38) or playing is on (Fig. 12 S40)” (OA at 4). Although *Terui* discloses

various “operation buttons and switches” (Fig. 1; col. 4, lines 38-40) as well as determining whether “the pressed button is the recording button” and whether “the playing button . . . has been pressed” (col. 11, lines 11-13; col. 12, lines 21-23; Fig. 12, S38, S40), *Terui* does not disclose “means for controlling said recording means and said reproducing means in accordance with the operation mode set by said setting means when said determining means determines that the apparatus is connected to the external device,” as recited in claim 5.

For at least the foregoing reasons, the applied art does not teach or suggest each and every element recited in claim 5. In addition, for at least the reasons explained above in connection with claim 1, the requisite motivation for combining *Burrows* and *Terui* is lacking. A case for *prima facie* obviousness has thus not been established, and the § 103(a) rejection of independent claim 5 should be withdrawn.

Independent claim 17 recites a combination including:

determining whether or not said reproducing means performs a reproduction when a recording command is issued; and

disabling said reproducing means and enabling said recording means when it is determined that said reproducing means performs the reproduction.

Although claim 17 is of different scope than claim 1, the § 103(a) rejection of claim 17 should be withdrawn for at least reasons similar to those presented above in connection with claim 1.

Independent claim 21 recites a combination including:

selectively setting an operation mode; and

controlling said recording means and said reproducing means in accordance with the operation mode when it is determined that the apparatus is connected to the external device.

Although claim 21 is of different scope than claim 5, the § 103(a) rejection of claim 21 should be withdrawn for at least reasons similar to those presented above in connection with claim 5.

Claims 2-4 depend upon claim 1; claims 6-8 depend upon claim 5; claims 18-20 depend upon claim 17; and claims 22-24 depend upon claim 21. The § 103(a) rejection of claims 2-4, 6-8, 18-20, and 22-24 should be withdrawn at least because of such dependency. Applicants thus request withdrawal of the § 103(a) rejection and the timely allowance of claims 1-8 and 17-24.

New claims 33 and 34

New independent claim 33 recites, *inter alia*, “means for disabling the reproducing means to stop reproduction of the content and enabling the recording means to start recording of a new content when said determining means determines that the apparatus is connected to the external device.” Neither *Burrows*, nor *Terui*, nor any combination thereof, teaches or suggests at least this feature. For at least this reason, new claim 33 should be allowed over those references. New claim 34 should be allowed at least because of its dependence upon independent claim 33. Applicants therefore request the timely allowance of new claims 33 and 34.

Conclusion


Applicants request the Examiner’s reconsideration of the application in view of the foregoing, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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